

REMARKS

Claims 1-9, 11-20, 22-24, and 26-47 are presently pending in the case. Claims 1, 15, 22 and 26 have been amended. The amendments are supported by the specification as originally filed.

Claim rejections under 35 USC §112

The Examiner rejected claims 1-5, 11-19, 22, 23, and 26-40 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

According to the Examiner, independent claims 1, 15, 22 and 26 were missing an essential element. The Examiner's objection to the language in claims 1, 15, 22 and 26 is believed to be overcome by the above amendments. It should be noted that while an opening into the receptacle might be considered essential, there is nothing in the specification that indicates the manner in which the opening is achieved is essential. Thus, the opening could be created within the chamber, as shown in the version of Figures 4A-4E, or could be provided prior to insertion, as shown in the version of Figures 1A-1C.

Applicant requests withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

Claim rejections under 35 USC §102

The Examiner rejected claims 1-7, 9, 11-13, 15-20, 22-24, 26-31, 33-35, 37-39, 42, 44, 45 and 47 under 35 USC §102(b) as being anticipated by U.S. Patent 3,795,244 to Lax et al (hereinafter Lax et al). The rejection is traversed.

“A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” In re Paulsen, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). “Invalidity on the ground of ‘anticipation’ requires lack of novelty of the invention as claimed ... that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim.” Karsten Manufacturing Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383 (Fed. Cir. 2001). Thus, for a rejection under 35 USC §102 to be proper, the reference relied upon must disclose each and every element of the claimed invention and the elements must be arranged as in the claim. Non-disclosure of a single element, feature or limitation of the claim or an arrangement other than that which is claimed negates anticipation.

Lax et al does not anticipate independent claim 1, for example. Claim 1 is to an aerosolization apparatus comprising a body defining a chamber sized to receive a receptacle in a manner which allows the receptacle to move within the chamber, wherein the chamber has a sidewall with a cross-section that is non-circular and wherein the receptacle contacts the non-circular cross-section of the sidewall when the receptacle moves within the chamber. Lax et al does not disclose these features. More specifically, Lax et al lacks a non-circular sidewall that contacts a receptacle. Since Lax et al does not disclose each and every feature set forth in claim 1, it does not anticipate the claim.

The Examiner's comments do not serve to establish Lax et al as an anticipatory reference. The Examiner points to element 22 as being the non-circular cross-section. However, element 22 of Lax et al is a base upon which hollow shaft 30 is driven. Element 22 does not contact receptacle 42 of Lax et al. In actuality, the receptacle 42 of Lax et al merely sits within recess 40 of Lax et al and does not contact a sidewall of a chamber.

Applicant requests withdrawal of the rejection of claim 1 under 35 U.S.C. §102(b). In addition, Applicant requests withdrawal of the rejection of claims 2-9 and

11-14 which depend from claim 1 and are not anticipated by Lax et al for at least the same reasons as claim 1.

Additionally, Lax et al does not anticipate independent claim 15. Claim 15 is to an aerosolization apparatus comprising a body defining a chamber sized to receive a receptacle in a manner which allows the receptacle to move within the chamber, wherein the chamber has a sidewall with a cross-section that is non-circular and wherein the receptacle contacts the non-circular cross-section of the sidewall when the receptacle moves within the chamber. Lax et al does not disclose these features. More specifically, Lax et al lacks a non-circular sidewall that contacts a receptacle. Since Lax et al does not disclose each and every feature set forth in claim 15, it does not anticipate the claim.

Applicant requests withdrawal of the rejection of claim 15 under 35 U.S.C. §102(b). In addition, Applicant requests withdrawal of the rejection of claims 16-20, 29-31, 41 and 42 which depend from claim 15 and are not anticipated by Lax et al for at least the same reasons as claim 15.

Lax et al also does not anticipate independent claim 22. Claim 22 is to an aerosolization apparatus comprising a body defining a chamber sized to receive a receptacle in a manner which allows the receptacle to move within the chamber, wherein the chamber has a sidewall with a cross-section that is non-circular and wherein the receptacle contacts the non-circular cross-section of the sidewall when the receptacle moves within the chamber. Lax et al does not disclose these features. More specifically, Lax et al lacks a non-circular sidewall that contacts a receptacle. Since Lax et al does not disclose each and every feature set forth in claim 22, it does not anticipate the claim.

Applicant requests withdrawal of the rejection of claim 22 under 35 U.S.C. §102(b). In addition, Applicant requests withdrawal of the rejection of claims 23, 24, 33-35, 43 and 44 which depend from claim 22 and are not anticipated by Lax et al for at

least the same reasons as claim 22.

Lax et al does not anticipate independent claim 26 either. Claim 26 is to a method of aerosolizing a pharmaceutical formulation, the method comprising inserting a receptacle into a chamber having a non-circular cross section and causing air to flow into the chamber thereby causing the receptacle to move about the non-circular cross section to aerosolize the pharmaceutical formulation. Lax et al does not disclose these features. More specifically, Lax et al lacks a non-circular sidewall that the receptacle moves about. Since Lax et al does not disclose each and every feature set forth in claim 26, it does not anticipate the claim.

Applicant requests withdrawal of the rejection of claim 26 under 35 U.S.C. §102(b). In addition, Applicant requests withdrawal of the rejection of claims 27, 28, 37-39 and 45-47 which depend from claim 26 and are not anticipated by Lax et al for at least the same reasons as claim 26.

Claim rejections under 35 USC 103(a)

The Examiner rejected claims 14, 32, 36 and 40 under 35 USC §103(a) as being unpatentable over Lax et al. The rejection is traversed.

Lax et al does not render claims 14, 32, 36 and 40 unpatentable. Claim 14, 32, 36 and 40 depend from claims 1, 15, 22 and 26, respectively. Lax et al does not render claims 1, 15, 22 and 26 unpatentable, as discussed above. Since the independent claims are allowable over Lax et al, so are the claims depending therefrom.

Applicant requests withdrawal of the rejection of claims 14, 32, 36 and 40 under 35 U.S.C. §103(a).

Claim rejections under judicially created doctrine of Double Patenting

The Examiner rejected claims 1-9, 15-20, 22-24, 26-28 and 41-47 under the judicially created doctrine of double patenting as being unpatentable over the claims of U.S. Patent 7,516,741.

The Examiner provisionally rejected claims 1-5, 15-19, 22, 23 and 26-28 under the judicially created doctrine of double patenting as being unpatentable over the claims of U.S. Patent Application 10/295,783.

Since the claims have not been indicated as being otherwise in condition for allowance, a response to the Double Patenting rejection at this time would be premature. Therefore, the Applicant is holding such response in abeyance until such time as the claims are indicated allowable but for the Double Patenting issue.

Allegedly Duplicate Claims

The Examiner advised Applicant that it is the Examiner's position that claims 15 and 22 are duplicates of claim 1. The Examiner is not correct in this determination. Each of claims 1, 15 and 22 defines the non-circular feature in a different manner and is not of identical scope. Applicant requests reconsideration of the Examiner's position.

Conclusion

The claims are allowable for the reasons given above. Thus, the Examiner is respectfully requested to reconsider the present rejections and allow the presently pending claims. Should the Examiner have any questions, the Examiner is requested to call the undersigned at the number given below.

Respectfully submitted,

JANAH & ASSOCIATES

Dated: December 16, 2010

By: 

Guy V. Tucker
Reg. No. 45,302

Please send all correspondence to:

Guy Tucker
Janah & Associates
650 Delancey Street, Suite 106
San Francisco, CA 94107
Phone: (415) 538-1555
Fax: (415) 538-8380